



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,394	12/21/2001	Edward Michael Silver	36968-263531	1038
23552	7590	12/19/2003		
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
			EXAMINER SINGH, RAMNANDAN P	
			ART UNIT 2644	PAPER NUMBER 10
DATE MAILED: 12/19/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,394

Applicant(s)

SILVER ET AL.

Examiner

Dr. Ramnandan Singh

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

Content of Specification

1. (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
2. The title of the invention is too long. A suggested title is given below:

APPARATUS AND METHOD FOR MONITORING A CALL FORWARDED TO A
NETWORK-BASED VOICE MAIL SYSTEM

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6, 9-12, 13, 14-15, 18, 22, 25, 30, 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Gardell et al [US 6,011,896].

Regarding Claim 1, Gardell et al teaches a real-time voice mail monitoring and call control system over the internet shown in Fig. 2 [col. 2, lines 17-39] that monitors a call forwarded to a network-based voice mail system (VMS) [col. 9, lines 55-58; col. 10, lines 25-27], comprising :

Art Unit: 2644

a local exchange carrier (LEC) switch 80 (or a central office) connected to customer premises equipment (CPE) 110 and to the VMS terminal 150 via gateway 70; the LEC switch 80 operative to receive a call from a calling party 100 to a called party 110, forward the call to the VMS 150 via the gateway 70, wherein the gateway 70 receives a call alerting signal (11) (which is a call monitoring provisional signal) from the VMS , and then transmits this information using a call alerting signal (12) (which is also a call monitoring provisional signal) to the LEC switch 80. After receiving this alerting signal (12), the LEC switch 80 sends a call monitoring alert (13) to the CPE 110, wherein the VMS 150 is operative to send the call monitoring provisional signal to the LIE switch 80 [Abstract; Figs. 2, 3A, 3B; col. 4, line 8 to col. 5, line 26].

Claim 13 is essentially similar to Claim 1 except for receiving an intercept tone from a called party's telephone. Gardell et al teaches a voice mail intercept service terminal (VMIST) 340 for receiving an intercept tone from the customer's telephone 310; and causing the called party to be connected to a calling party [col. 7, lines 9-33].

Claim 18 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 1.

Claim 30 is essentially similar to Claim 1 except for a speaker assembly, wherein the speaker assembly for monitoring a call is an inherent feature of a telephone answering system. For example, Manicone [US 5,748,718] shows a telephone

Art Unit: 2644

monitoring system having a speaker which is connected to audibly monitor a call on a telephone line [col. 4, lines 47-65].

Regarding Claims 6 and 9, the limitations are shown above.

Regarding Claims 10, 12, 22, 25, 34, 36-37, see Figs. 6A and 6B.

Regarding Claim 11, Gardell et al teaches generating DTMF signal by pressing keys used for generating intercept signals and other commands [col. 5, lines 57-63].

Claims 17, 24, 35 essentially similar to Claim 11 and are rejected for the reasons stated above apropos of Claim 11.

Regarding Claim 14, Gardell et al teaches prompting the subscriber at the telephone device 210 to enter a password, and authenticate the password [col. 5, line 50 to col. 6, line 22].

Claim 38 is essentially similar to Claim 14 and is rejected for the reasons stated above apropos of Claim 14.

Regarding Claim 15, the voice mail code (i.e. password) is transmitted , e.g. , as DTMF signals [col. 5, lines 57-63].

5. Claims 13-17, 18-25, 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers et al [US 5,946,386].

Regarding Claim 13, Rogers et al teaches a method for monitoring a call forwarded to a network-based voice mail system (VMS) 606 using a Call Management System shown in Fig. 1, comprising sending a call to the VMS [col. 13, lines 40-44; Abstract]; receiving a message about the forwarded call [col. 27, line 61 to col. 28, line 7; col. 28, lines 55-67]; sending a call monitoring alert message [col. 29, lines 1—28]; and intercepting a telephone call [col. 44, line 28 to col. 45, line 62; col. 1, line 63 to col. 2, line 3; Fig. 1; col. 6, lines 46-62; col. 13, lines 40-44].

Claim 18 is essentially similar to Claim 13, and is rejected for the reasons stated above.

Claim 30 is essentially similar to Claim 13 except for a speaker assembly, wherein the speaker assembly is an inherent feature of a telephone call monitoring system.

Regarding Claim 14, Rogers et al teaches identifying a called party 111 or 113 through the digits entered (i.e. code), through voice recognition or otherwise [col. 11, lines 21-43].

Regarding Claim 16, when a user receives a new voice-mail message, the Call Management System is notified [col. 28, lines 55-67].

Regarding Claim 17, a call management computer intercepts a telephone call wherein the incoming call type signal having specified DTMF is also determined [col. 6, lines 55-59; col. 11, lines 44-50].

Claim 24 is essentially similar to Claim 17 and is rejected for the reasons stated above apropos of Claim 17.

Regarding Claims 31-32, Rogers et al generating a distinctive ringing sound to alert a user [col. 3, lines 53-65].

Claim 21 is essentially similar to Claim 32 and is rejected for the reasons stated above.

6. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
7. Claims 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Muller [US 6,295,341 B1].

Regarding Claim 26, Muller teaches a method for monitoring a call forwarded to network-based voice mail system (VMS) 6 shown in Fig. 1, comprising : receiving a call forwarded to a voice mailbox associated with a called party number from a local service provider 4 (local switch is not shown); and playing a greeting for the caller while monitoring is in process [col. 2, lines 46-65; col. 4, lines 1-25; col. 6, line 61 to col. 7, line 3; col. 7, lines 41-53].

Regarding Claim 27, Muller teaches using a voice mail code to access a mail box 12 [col. 2, lines 25-45; col. 3, line 40 to col. 4, line 3; col. 4, lines 50-59].

Regarding Claim 28, Muller uses a number of keys to enter a PIN code to access a mail box 12 [Fig. 2; col. 1, line 66 to col. 2, line 9; col. 7, lines 54-60]. This inherently transmits the code using a DTMF signal.

Regarding Claim 29, Muller teaches that the remote answering device 2 send a few bits of data to the network-based voice-mail system 6 via local service provider 4, as shown in Fig. 1, before disconnecting the line [col. 7, lines 34-37].

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2644

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-5, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardell et al as applied to Claims 1 and 18 above, and further, in view of Muller [US 6,295,341 B1].

Regarding Claim 2, Gardell et al does not teach expressly sending a call monitoring signal to the CO after the calling party terminates the line.

Muller teaches that the remote answering device 2 send a few bits of data to the network-based voice-mail system 6 via local service provider 4, as shown in Fig. 1, before disconnecting the line [col. 7, lines 34-37].

Gardell et al and Muller are analogous art because they are from a similar problem solving area, viz. , telephone call monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the method of sending a call monitoring signal to the VMS via the CO at the end of the call recording of Muller to the Gardell's system in order to close the process with the VMS.

Art Unit: 2644

Claim 23 is essentially similar to Claim 2.

Regarding Claims 3-4, Muller teaches that the VMS play a voice mail greeting [Abstract; col. 6, line 61 to col. 7, line 3; col. 7, lines 41-53].

Regarding Claim 5, Muller teaches a message indicator 22 [col. 4, lines 39-65].

10. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al as applied to Claim 30 above, and further, in view of Manicone [US 5,748,718].

Regarding Claim 33, Rogers et al does not teach alerting a user using a visual indicator.

Manicone teaches applying a speaker and **display** (i.e. visual) monitor which is connected to audibly and visually monitor signals on the telephone line in the premises when the manually actuatable switch is actuated [col. 4, lines 47-65; col. 2, line 59 to col. 3, line 18].

Rogers et al and Manicone are analogous art because they are from a similar problem solving area, viz. , telephone monitoring system.

Art Unit: 2644

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the visual indicator of Manicone to the Rogers' call monitoring system to provide detection and visual indication of incoming telephone calls [manicone; col. 1, lines 14-21].

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardell et al as applied to Claim 6 above, and further, in view of Manicone [US 5,748,718].

Regarding Claim 8, Rogers et al does not teach alerting a user using a visual indicator.

Manicone teaches applying a speaker and **display** (i.e. visual) monitor which is connected to audibly and visually monitor signals on the telephone line in the premises when the manually actuatable switch is actuated [col. 4, lines 47-65; col. 2, line 59 to col. 3, line 18].

Gardell et al and Manicone are analogous art because they are from a similar problem solving area, viz. , telephone monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the visual indicator of Manicone to the Gardell's call monitoring

Art Unit: 2644

system to provide detection and visual indication of incoming telephone calls [manicone; col. 1, lines 14-21].

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardell et al as applied to Claim 6 above, and further, in view of Rogers et al [US 5,946,386].

Regarding Claim 7, Gardell et al does not teach that each CPE generate a distinctive sound.

Rogers et al generating a distinctive ringing sound to alert a user [col. 3, lines 53-65].

Gardell et al and Rogers et al are analogous art because they are from a similar problem solving area, viz. , telephone call monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the distinctive sound generation of Rogers et al to the Gardell's call monitoring system to alert a particular user [Rogers et al; col. 3, lines 61-63].

13. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardell et al as applied to Claim 18 above, and further, in view of Muller [US 6,295,341 B1].

Regarding Claims 19-20, Gardell et al does not teach generating a greeting sound.

Muller teaches playing a greeting sound for the caller while monitoring is in process [col. 2, lines 46-65; col. 4, lines 1-25; col. 6, line 61 to col. 7, line 3; col. 7, lines 41-53].

Gardell et al and Muller are analogous art because they are from a similar problem solving area, viz. , telephone call monitoring system.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the technique of a greeting by Muller to the Gardell's call monitoring system to alert a particular user.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- (i) Howe et al[US 5,471,519], see Fig. 1;
- (ii) Mukherjee et al [US 6,449,474 B1] , see Fig. 8; and
- (iii) Tatchell et al [US 5,905,774], see Fig. 1.

Art Unit: 2644

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Ramnandan Singh whose telephone number is (703)308-6270. The examiner can normally be reached on M-F(8:00-4:30).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester Isen can be reached on (703)-305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-0377.

Dr. Ramnandan Singh
Examiner
Art Unit 2644



December 2, 2003



FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2644